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09/757,105	01/08/2001	Robert L. Pitts	TI-29117	6920

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EXAMINER

FOX, BRYAN J

ART UNIT PAPER NUMBER

2686

DATE MAILED: 06/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,105

Applicant(s)

PITTS, ROBERT L.

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the coverage area" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the coverage area" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8 and 14, 16 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi (US006052577A).

Regarding claims 8 and 14, Taguchi discloses a portable telephone system with base stations A, B and C (see column 3, lines 5-12 and figure 1), which reads on the

claimed "at least one relatively long range base station", and a communication prohibiting/limiting station 2 within cell area a such that an area 10 is set as a communication limitation area 10 where use of a portable telephone 3 as a mobile station is prohibited (see column 3, lines 13-17 and figure 1), which reads on the claimed "short-range base station having a short coverage area relative to said at least one long-range base station and disposed within the coverage area of said at least one relatively long-range base station; said short-range base station controlling all wireless mobile communications to and/or from said at least one relatively long range base station within said short coverage area, said short-range base station restricting operation of communication devices disposed within said short coverage area which are capable of communicating with said at least one relatively long range base station".

Regarding claims 16 and 21, Taguchi discloses that in response to the limitation signal, the mobile station issues a notice indicating that portable telephone is positioned in use limitation area and displays that portable telephone is positioned in use limitation area (see figure 3, steps 104, 105 and 106), which reads on the claimed "means responsive to said short range base station for providing at least one predetermined function at said communication devices".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of Stein (US005771468A). Taguchi fails to disclose that controlling the wireless communications would be done in more than one format on more than one channel.

Stein discloses a base station capable of communicating in a plurality of telecommunications systems where the systems operate according to different standards (see column 2, lines 28-31), which reads on the claimed "controlling communications is done in more than one format". Furthermore, since the communications are done in more than one format, they must be done in more than one channel as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify the system disclosed by Taguchi to include the multi-system compatibility disclosed by Stein in order to provide compatibility with multiple systems.

8. Claims 17-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of da Silva (US006496703B1).

Regarding claims 17 and 22, Taguchi fails to expressly disclose altering predetermined types of communications from said communication devices to said long range base station.

Da Silva discloses a system for disabling wireless communication devices where, in the case of an emergency call, the caller would be asked if an emergency exists, and if so to press a number on the key pad and the caller could be handled by a service person or automatically and the CSP would enable the cellular phone and complete the call (see column 9, lines 33-42), which reads on the claimed "altering predetermined types of communications from said communication devices to said long range base station".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Taguchi with da Silva to include the above allowing of emergency calls in order to provide immediate assistance to the user in case of emergency.

Regarding claims 18 and 23, Taguchi fails to expressly disclose precluding audible responses.

Da Silva discloses a system that keeps a record of cellular phones having vibrating announcers, rather than ringing announcers and allow these phones to operate in a zone where ringing is prohibited (see column 7, lines 38-52), which reads on the claimed "precluding audible responses at said communication devices".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Taguchi with da Silva to include the above disabling ringing

while allowing vibrating alerts in order to notify the user of the incoming call without introducing interference.

Regarding claims 19 and 24, the combination of Taguchi and da Silva discloses a system that keeps a record of cellular phones having vibrating announcers, rather than ringing announcers and allow these phones to operate in a zone where ringing is prohibited (see da Silva column 7, lines 38-52), which reads on the claimed "causing a response to be converted from an audible response to a non-audible response".

Regarding claims 20 and 25, the combination of Taguchi and da Silva discloses a system for disabling wireless communication devices where, in the case of an emergency call, the caller would be asked if an emergency exists, and if so to press a number on the key pad and the caller could be handled by a service person or automatically and the CSP would enable the cellular phone and complete the call (see da Silva column 9, lines 33-42), which reads on the claimed "altering predetermined types of communications from said communication devices to said long range base station".

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 8 and 14-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJF

*Nguyen Vo*  
6-7-04

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PRIMARY EXAMINER